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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/03/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/537,965

Applicant(s)

ROGSON, ARIEL S.

Examiner

Doug Hutton

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Applicant's Response

In Paper No. 4, Applicant amended the Specification, amended Claims 1, 11, 23, 26 and 29, added new Claims 31 and 32, and argued against all objections and rejections previously set forth in Paper No. 3.

The objection to the Specification and all rejections previously set forth in Paper No. 3 are withdrawn. The objections to Claims 1 and 29 are also withdrawn.

Claim Objections

Claim 10 is objected to because of the following informalities:

- the specification describes this portion of the present invention from Page 7, Line 31 to Page 8, Line 4 and indicates that the alternative corrections are entered **by the user**. However, Claim 1, from which Claim 10 depends, recites that the updating of the static list is done **by the computer**. Accordingly, Claim 10 does not accurately describe the invention.

Claims 10 and 12 are objected to because of the following informalities:

- the phrase "an alternate" in Line 2 in Claim 10 should be amended to — the — and the term "the" in Line 3 should be amended to — an alternate — because it

is the "correctly spelled word" that is replaced with an "alternate correctly spelled word"; Claim 12 has the same problem.

Claim 13 is objected to because of the following informalities:

- the term "alternate" in Line 6 should be deleted because it is the "correctly spelled word," not the "alternate" correctly spelled word, that is replaced in the static update list.

Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 25 fails to further limit the subject matter of Claim 24 because every "counter" (Claim 24, Line 2) inherently includes an "incrementer" that "increments" the counter (Claim 25, Line 2). Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9:

The claim recites the limitation “wherein removing the misspelled word and entering the correctly spelled word is done **by a user**” in Lines 1-2. This limitation is indefinite as explained below.

Claim 9 depends from Claim 8 and further defines the step of “removing the misspelled word and entering the correctly spelled word” (see Claim 9, Lines 1-2). These steps are expressly recited in Claim 8 (see Lines 3-4). Claim 8 depends from Claim 1 and further defines the step of “receiving a corrected spelling” (see Lines 1-2). This step is expressly recited in Claim 1 (see Line 6). Claim 1 also recites that the method is “**executed by the computer**” (Line 3).

Accordingly, the above limitation of Claim 9 does not correspond with Claim 1 and is thus indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Walfish et al., U.S. Patent No. 6,047,300.

Claim 1:

Walfish discloses a method for updating a static update list of pairs of misspelled and correctly spelled words in a document with a spell checking program on a computer (see Column 13, Line 60 through Column 14, Line 41), the method comprising:

- parsing a misspelled word as entered into the document (see Column 2, Lines 65-67);
- verifying that the misspelled word is not spelled correctly (see Column 2, Lines 65-67);
- receiving a corrected spelling of the misspelled word (see Column 3, Lines 31-33); and
- updating the static update list of pairs of misspelled and correctly spelled words (see Column 3, Lines 34-47 – the invention automatically adds corrected word pairs to the AutoCorrect List).

Claim 2:

Walfish discloses the method according to Claim 1, wherein updating the static list includes tracking a measure of how useful it would be to add the misspelled word and the correctly spelled word to the static update list (see Column 13, Line 60 through Column 14, Line 10; see Column 3, Lines 48-62 – Walfish discloses a “tracking measure” in that: 1) if a misspelled word is replaced with a replacement word, then the

corrected word pair is added to the AutoCorrect List; and 2) if the user rejects a replacement word in favor of the original word, then the original word is placed in the Exceptions List and the corrected word pair is not added to the AutoCorrect List; these features “track a measure of how useful it would be to add the misspelled word and the correctly spelled word to the static update list”).

Claim 3:

Walfish discloses the method according to Claim 2, wherein tracking a measure includes incrementing a count of how many times the misspelled word has been parsed and the correctly word received (see Column 13, Line 60 through Column 14, Line 10 – Walfish discloses “incrementing a count of how many times the misspelled word has been parsed and the correctly word received” in that the corrected word pair is added to the AutoCorrect List when the count reaches one).

Claim 4:

Walfish discloses the method according to Claim 3, wherein updating the static update list includes adding the misspelled and correctly spelled words to the static update list if the count of how many times the misspelled word has been parsed and the correctly spelled word received exceeds a threshold (see Column 13, Line 60 through Column 14, Line 10 – the corrected word pair is added to the AutoCorrect List when the count exceeds the threshold of zero).

Claim 5:

Walfish discloses the method according to Claim 1, wherein updating the static update list of pairs of misspelled and correctly spelled words includes storing the misspelled word and correctly spelled word in a dynamic update list (see Column 6, Line 28 through Column 13, Line 57 – after the third stage of the replacement test, the corrected word pair is stored in a “dynamic update list” before it is subsequently added to the AutoCorrect List).

Claim 6:

Walfish discloses the method according to Claim 5, wherein updating the static update list of pairs of misspelled and correctly spelled words further includes updating the static update list of pairs of misspelled and correctly spelled words from the dynamic update list (see Column 13, Line 60 through Column 14, Line 41 – the AutoCorrect List is “updated fro the dynamic update list” in that corrected word pairs are added to the AutoCorrect List from the “dynamic update list”).

Claim 7:

Walfish discloses the method according to Claim 1, wherein verifying that the misspelled word is not spelled correctly includes finding that the misspelled word is not in the static update list of pairs of misspelled and correctly spelled words (see Column 6, Line 38 through Column 7, Line 10 – the invention is an automatic spell checker that

will find that the misspelled word is not in the AutoCorrect List but still verify that the word is misspelled, as explained in the cited text).

Claim 8:

Walfish discloses the method according to Claim 1, wherein receiving a corrected spelling includes:

- removing the misspelled word from the document (see Column 13, Lines 50-58);
and
- entering the correctly spelled word into the document (see Column 13, Lines 50-58).

Claim 9:

Walfish discloses the method according to Claim 8, wherein removing the misspelled word and entering the correctly spelled word is done by a user (see Column 1, Line 1 through Column 24, Line 12 – the invention discloses this limitation, as indicated in the cited text).

Claim 10:

Walfish discloses the method according to Claim 1, wherein updating the static list of pairs of misspelled and correctly spelled words includes replacing the correctly spelled word for the misspelled word in the static update list with an alternate correctly

spelled word (see Column 1, Line 1 through Column 24, Line 12 – the invention discloses this limitation, as indicated in the cited text).

Claims 11, 12 and 16- 22:

These claims merely recite computer software that performs the method of Claims 1, 10, 7-9 and 2-5, respectively. Thus, Walfish discloses every limitation of these claims using the same rationale specified in the above rejections.

Claims 13:

Walfish discloses the computer-readable medium containing a program according to Claim 12, wherein the updating software further includes:

- presentation software to present a user with a choice of the correctly spelled word and the alternate correctly spelled word as the correction for the misspelled word;
- second reception software to receive from the user a selected correction word; and
- substitution software to substitute the selected correction word for the alternate correctly spelled word in the static update list (Column 1, Lines 29-43 – the prior art discloses each of these steps, as specified in the cited text).

Claims 14:

Walfish discloses the computer-readable medium containing a program according to Claim 13, wherein:

- the presentation software includes display software to display a dialog box on screen; and
- the second reception software includes reception software to receive a selection in the dialog box from the user (Column 1, Lines 29-43 – the prior art discloses each of these steps, as specified in the cited text).

Claims 15:

Walfish discloses the computer-readable medium containing a program according to Claim 13, wherein:

- the second reception software includes third reception software to receive from the user the rejection of both the correctly spelled word and the alternate correctly spelled word (Column 1, Lines 28-43 – the prior art discloses this step, as specified in the cited text); and
- the substitution software includes removal software to remove the misspelled word and both the correctly spelled word and the alternate correctly spelled word from the static update list (Column 14, Line 44 through Column 18, Line 30 – the spelling embodiment “removes” the correctly spelled word and the alternate correctly spelled word from the static update list in that it adds the “exception” word to the Exceptions List, thereby disabling the spelling embodiment from automatically replacing the “exception” word with its “correct” spelling).

Claim 23:

Walfish discloses an apparatus for correcting misspelled words in a document, the apparatus comprising:

- a computer;
- a document editor program executable on the computer;
- a spell-checking program executable on the computer in conjunction with the document editor program (see Column 1, Line 1 through Column 24, Line 12 – the invention discloses a computer with a word processor that has a spell checker);
- a static update list of pairs of first misspelled and known correctly spelled words, the static update list stored on the computer (see Column 3, Lines 34-47 – the AutoCorrect List that is stored on the computer includes pairs of “first” misspelled and known correctly spelled words);
- a dynamic update list, the dynamic update list stored on the computer and including pairs of second misspelled words and possibly correctly spelled words (see Column 6, Line 28 through Column 13, Line 57; see Column 18, Line 31 through Column 19, Line 19 – the “second” word pairs are added to and stored in a “dynamic update list” stored on the computer, as indicated in the cited text);
and
- a measure for each pair of second misspelled words and possibly correctly spelled words indicating whether it is worth adding at least one of the pairs of second misspelled words and possibly correctly spelled words to the static

update list (see Column 13, Line 60 through Column 14, Line 10; see Column 3, Lines 48-62 – Walfish discloses an “indicating measure” for the “second” word pairs in that: 1) if a misspelled word is replaced with a replacement word, then the corrected word pair is added to the AutoCorrect List; and 2) if the user rejects a replacement word in favor of the original word, then the original word is placed in the Exceptions List and the corrected word pair is not added to the AutoCorrect List; these features “track a measure of how useful it would be to add the misspelled word and the correctly spelled word to the static update list”).

Claim 24:

Walfish discloses the apparatus of Claim 23, wherein the measures of the dynamic update list are counters (see Column 13, Line 60 through Column 14, Line 10 – Walfish discloses “counters” in that the “second” word pair is added to the AutoCorrect List when the count reaches one).

Claim 25:

Walfish discloses the apparatus of Claim 24, the apparatus further comprising an incrementer incrementing the counters of the dynamic update list (see Column 13, Line 60 through Column 14, Line 10 – Walfish discloses an “incrementer” in that the “second” word pair is added to the AutoCorrect List when the counter is incremented by one).

Claim 26:

Walfish discloses the apparatus of Claim 23, the apparatus further comprising a first update unit for updating the static update list from the dynamic update list (see Column 3, Lines 34-47 – Walfish discloses a “first update unit” in that the invention automatically adds corrected word pairs to the AutoCorrect List).

Claim 27:

Walfish discloses the apparatus of Claim 23, the apparatus further comprising a second update unit for updating the dynamic update list from the document editor program (see Column 6, Line 28 through Column 10, Line 10; see Column 13, Line 60 through Column 14, Line 41; see Column 18, Line 33 through Column 19, Line 19 – Walfish discloses a “second update unit” that updates the “dynamic update list” from the word processor in three ways: 1) the “dynamic update list” is continuously updated throughout the replacement test; 2) the “dynamic update list” is “updated” after a word pair is added to the AutoCorrect List from the dynamic update list; and 3) the “dynamic update list” is “updated” when “replacement word pairs” are added to the replacement notice, as indicated in the cited text).

Claim 28:

Walfish discloses a data structure in a computer memory device for storing a dynamic update list of correctly spelled words as replacements for misspelled words , the data structure comprising:

- a series of entries (see Column 6, Line 28 through Column 13, Line 57; see Column 18, Line 31 through Column 19, Line 19 – the “entries” are word pairs contained in a “dynamic update list” stored on the computer, as indicated in the cited text), wherein each entry includes:
 - a misspelled word (each “entry” includes a misspelled word, as indicated in the cited text);
 - a correctly spelled word (each “entry” includes a correctly spelled word, as indicated in the cited text); and
 - a measure indicating whether it is worth adding the misspelled word and the correctly spelled word to a static update list (see Column 13, Line 60 through Column 14, Line 10; see Column 3, Lines 48-62 – Walfish discloses an “indicating measure” for the “second” word pairs in that: 1) if a misspelled word is replaced with a replacement word, then the corrected word pair is added to the AutoCorrect List; and 2) if the user rejects a replacement word in favor of the original word, then the original word is placed in the Exceptions List and the corrected word pair is not added to the AutoCorrect List; these features “track a measure of how useful it would be to add the misspelled word and the correctly spelled word to the static update list”).

Claim 29:

Walfish discloses the data structure of Claim 28, wherein the measure indicating whether it is worth adding the misspelled word and the correctly spelled word to the static update list includes a counter storing the number of times the correctly spelled word replaced the misspelled word (see Column 13, Line 60 through Column 14, Line 10 – Walfish discloses a “counter” in that the corrected word pair is added to the AutoCorrect List when the count reaches one).

Claim 30:

Walfish discloses the data structure of Claim 28, wherein the entries are organized to optimize searching, insertion and deletion (see Column 1, Line 1 through Column 24, Line 12 – the invention discloses this limitation, as indicated in the cited text).

Claim 31:

This claim merely combines the limitations of Claims 1, 2 and 5. Thus, Walfish discloses every limitation of this claim as indicated in the above rejections for Claims 1, 2 and 5.

Claim 32:

This claim merely recites computer software that performs the method of Claim 2. Thus, Walfish discloses every limitation of these claims using the same rationale specified in the above rejection for Claim 2.

Response to Arguments

Applicant's arguments with respect to Claims 1-12 and 16-22 in regard to the admitted prior art have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to Claims 23-30 in regard to Neilsen have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 12 February 2004 that attempt to distinguish Applicant's invention from Walfish have been fully considered but they are not persuasive.

Arguments for Claims 2 and 19:

Applicant argues that Walfish fails to disclose a tracking measure. Applicant states that Walfish might disclose this feature if the claims had recited how useful it

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would be to keep a word pair *out* of the static update list. Applicant further argues that Walfish does not include a tracking measure for the *pair of words* because it lists only words that are not to be corrected despite being “misspelled.” Finally, Applicant argues that the method of the claims is operable by a computer and thus the user of the present invention does not make an overt indication that the word pair be tracked by the tracking measure. In contrast, Applicant argues, the tracking measure in Walfish requires user involvement. See *Applicant's Arguments* – Paper No. 4; Page 12, third full paragraph.

Examiner disagrees.

The pertinent language of the claims reads: “wherein updating the static list includes tracking a measure of how useful it would be to add the misspelled word and the correctly spelled word to the static update list.” This limitation reads on the example for the word “theatre” illustrated in Walfish at Column 14, Line 56 through Column 16, Line 10.

The “misspelled” word is evaluated by the replacement test, the replacement word “theater” is selected, and the word pair is placed into the “dynamic list.” The “tracking measure” (i.e., the Exceptions List) is then used to determine “how useful it would be to add the [word pair] to the static update list.” If the “misspelled” word is on the Exceptions List, then it would not be “useful” to add the word pair to the static update list (i.e., the AutoCorrect List). If the “misspelled” word is not on the Exceptions List, then it would be “useful” to add the word pair to the AutoCorrect List. Thus, the “tracking measure” does apply to the “pair of words.”

This example illustrates that the “tracking measure” requires no user involvement, provided the “misspelled” word is already on the Exceptions List. That is, if the word “theatre” is already on the Exceptions List, then referenced invention will go through the steps to determine how “useful” it would be to add the word pair to the static update list, as illustrated in the example.

Finally, Applicant’s statement that Walfish might disclose this feature if the claims had recited how useful it would be to keep a word pair *out* of the static update list is practically an admission that Walfish discloses the limitation. For if the “tracking measure” in Walfish determines how useful it would be to keep the word pair *out* of the static update list, then it also inherently determines how useful it would be to *add* the word pair to the static update list.

Applicant’s arguments filed 12 February 2004 – in response to the objections to Claims 10, 12 and 13 – that attempt to prove that the claims accurately describe Applicant’s invention have been fully considered but they are not persuasive.

Arguments for Claims 10, 12 and 13:

Applicant argues that there are three “the” words in Claim 10, Line 3 and that the examiner has been unclear as to which of these words should be replaced. Applicant further argues that the suggest amendments are wrong for two reasons: 1) they would create an antecedent basis problem with respect to the phrase “alternate correctly

spelled word”; and 2) they would not accurately describe the invention. See *Applicant's Arguments* – Paper No. 4; Page 9, fourth full paragraph through Page 10, first full paragraph.

Examiner disagrees.

Firstly, when the entire objection and Claim 10 are read together and fully considered, it is clear which “the” should be amended. Secondly, Applicant’s interpretation of the claim incorrectly does not correspond with the Specification, as explained below.

Claim 1 recites: “updating the static update list of pairs of misspelled and **correctly spelled words** by the computer” (emphasis added). Thus, each word pair includes a “correctly spelled word.” Claim 10 depends upon Claim 1 and recites: “wherein updating the static list of pairs of misspelled and correctly spelled words includes **replacing an alternate correctly spelled word** for the misspelled word in the static update list **with the correctly spelled word**” (emphasis added).

This embodiment of the present invention is discussed on Page 6, Lines 10-19 of the Specification. Lines 17-19 recite: “[t]he user then has the option of keeping the original correction in the static update list, [or] replacing the **original correction** with the user’s **alternate correction**” (emphasis added). Thus, the “original” is replaced by the “alternate.” In other words, the “correctly spelled word” is replaced by the “alternate correctly spelled word.”

For Applicant’s convenience, the examiner attaches a proposed amendment for Claim 10:

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10. The method according to Claim 1, wherein updating the static update list of pairs of misspelled and correctly spelled words includes replacing the correctly spelled word with an alternate correctly spelled word.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH
April 23, 2004


HEATHER HERNDON
SUPERVISORY PATENT EXAMINER
TECH CENTER 2100